

REMARKS

Claims 1, 2 and 11-19 are pending and claims 3-10 are cancelled in this application.

No new matter has been added to the claims or specification by the amendment.

Support for all amendments are found in the originally filed claims and specification.

Applicant requests consideration and entry into the record of the following amendments and remarks.

Overlapping Subject Matter in U.S. Appln. Ser. Nos. 10/031,844 ("U.S. '844 Appln.") and 10/333, 829 ("U.S. '829 Appln.")

In the interest of advancing prosecution in each of the above-identified applications, applicants have amended claim 1 of the instant U.S. '844 Appln. application to delete overlapping subject matter with that of U.S. '829 Appln.

In particular, the overlapping subject matter between the two aforementioned applications is identified by overlapping use of the functional group substituent term "heteroaryl" as associated with the R^4 group (where R^4 = a group CH_2-R^5 , where R^5 defines the overlapping substituent or functional group terms) of the U.S. '844 Appln. and the R^4 group of the U.S. '829 Appln. (where R^4 = a group $U-R^5$, where U is selected from CO, SO_2 and CH_2 , and R^5 is an optionally substituted bicyclic carbocyclic or heterocyclic ring system (A) as defined).

In particular, applicants have eliminated overlapping subject matter between the two aforementioned applications by deleting the term "heteroaryl" from the definition of the group R^5 in the U.S. '844 Appln.

No new matter has been added to the claims or specification by the amendment and support for all amendments are found in the originally filed claims and specification.

In light of this, applicants believe and earnestly solicit that the claims of the present invention now are in condition for allowance.

Rejection Under 35 U.S.C. §132 (New Matter)

Specific terms or phrases (identified below) introduced into the specification by the March 29, 2004 and April 1, 2004 Amendment are rejected as new matter for lacking support in the originally filed specification.

Applicants respectfully disagree with the specific terms or phrases identified by the Examiner as new matter and traverse for reasons below.

In addition, applicants respectfully request that the Examiner carefully review arguments previously set forth on the record and reiterated below which Applicants believe properly have addressed and eliminated any issues with the identified new matter rejections.

Each of the new matter terms identified as lacking support by the Examiner and applicants' corresponding response arguments are set forth below.

[1] The Examiner maintains that new matter was introduced by recitation of the term "optionally substituted C₁₋₄alkyl" as reflected by amendment to page 2, lines 34-37 to page 3, lines 1-8, which recites:

"R³ is in the 2-, 3- or 4-position and is: . . .

C₁₋₄ alkyl optionally substituted or ethenyl substituted with any of the substituents listed above for R³ and up to 3 groups R¹² independently selected from . . .";

Applicants point out that **no new matter has been introduced** into the instant specification as **support for the term "optionally substituted C₁₋₄alkyl"** or "**C₁₋₄ alkyl optionally substituted**" as defined within the definition of the substituent variable R³ is found in the **specification at page 6, line 4**, which recites:

"Preferred examples of R³" include hydrogen, optionally substituted aminocarbonyl; **optionally substituted (C₁₋₆)alkyl . . ."**

Also, see page 11, line 10-13 of the March 29, 2004 Amendment, also which shows support for the fact that the above-identified term is found in the specification at page 6, line 4.

[2] The Examiner further indicates that the specification does not support the new matter term "R¹² as defined in R³", which was introduced by an amendment at page 4, lines 11-19.

Applicants maintain that no new matter has been added with recitation of the phrase "R¹² as defined in R³".

In particular, the originally filed specification and claims of the above-identified application define the term R³ to include a list of organic functional group moieties which

specifically includes or encompasses the term R^{12} (see specification at page 3, line 8). The term R^3 may be substituted by any of the organic functional group or moieties defined for the term R^3 (see specification at page 2, lines 33 to 37 and page 3, lines 1 to 8) and by the term R^{12} (i.e., which further is defined by organic chemical functional group moieties defined in the specification at page 3, lines 8 to 24).

In light of the foregoing, the phrase " R^{12} as defined in R^3 " simply clarifies that the functional group substituent R^{12} is defined within or encompassed by the definition of the R^3 functional substituent group.

Support for this amendment is found throughout the originally filed disclosure or specification, for example:

- [1] see the specification definition of R^3 substituents at page 2, lines 33 to 37 to page 3, lines 1 to 24, where the term R^{12} is defined within the definition of R^3 as noted on lines 8 to 24 of page 3;
- [2] originally filed claim 1, which is part of the originally filed disclosure; see claim 1 at page 33, lines 28 to 37 to page 34, lines 1-7; and
- [3] further clarification was provided in amended claim 1 of the March 29, 2004 Amendment under the Listing of Claims at page 5, line 28, which recites within the definition of R^3 , the phrase "up to 3 groups for R^{12} . . ."

For example, applicants note that the term " R^{12} as defined in R^3 " further clarifies possible substitution for functional group terms "amino" or "aminocarbonyl" as associated with each of the functional groups R^6 , R^7 , R^8 , and R^9 .

Moreover, substitution of an amino or aminocarbonyl group as defined in the R^3 definition is within the R^{12} definition as the R^3 group cannot itself be an (optionally substituted) amino or aminocarbonyl moiety.

Applicants reiterate for the record that no new matter has been added to the claims or specification by the amendment and support for all amendments are found in the originally filed claims and specification.

In light of the above, applicants request that the above-identified rejections under 35 U.S.C. § 132 be withdrawn.

Applicants believe and earnestly solicit that the claims of the present invention now are in condition for allowance.

Rejection Under 35 U.S.C. §112, 1st and 2nd paragraphs

[1] Claims 1-2 and 11-19 are rejected under 35 U.S.C. §112, 1st para., for failure to comply with the written description requirement as claims contain subject matter not described in the specification to reasonably convey to one skilled in the art that the inventor at the time the application was filed had possession of the claims invention.

Applicants respectfully disagree and traverse the above-identified rejection for reasons below.

The Examiner states that recitation of the term "R¹² as defined in R³" lacks support in the specification and is new matter"

Applicants have provided explanations *supra* under the section identified as Rejection Under 35 U.S.C. §132, New Matter to indicate that the use of the term "R¹² as defined in R³" is not new matter as support for the aforementioned term is found in the originally filed disclosure (see above).

In light of the same reasons provided for the Rejection Under 35 U.S.C. §132, applicants request that the rejection under 35 U.S.C. §112, 1st para., for failure to comply with the written description requirement also be withdrawn.

[2] Claims 1-2 and 11-19 are rejected under 35 U.S.C. §112, 2nd para., for indefiniteness and failure to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

Applicants respectfully disagree and traverse the above-identified rejection for reasons below.

The Examiner has rejected the phrase "optionally further substituted . . ." which follows the term CH(R¹³)CONH₂" as unclear as to which group is to be further substituted.

Applicants have overcome this rejection by deletion of the following terms or phrase from claim 1:

"CH(R¹³)CO₂H or CH(R¹³)CONH₂ optionally further substituted by (C₁₋₆)alkyl, hydroxy(C₁₋₆)alkyl, aminocarbonyl(C₁₋₆)alkyl or (C₂₋₆)alkenyl; hydroxy(C₁₋₆)alkyl; carboxy; cyano or (C₁₋₆)alkoxycarbonyl"

The Examiner also has indicated that the term "optionally further substituted . . ." is unclear with regard to other groups defined in claim 1.

Applicants request further clarification by the Examiner in identifying other specific variable terms, if any, which may be unclear.

In light of the above, applicant requests that the above rejection under 35 U.S.C. § 112, 1st and 2nd paragraphs, be withdrawn.

CONCLUSION

In view of the above amendments and remarks, applicant believes that the claims of the present application are in condition for allowance and is earnestly solicited .

If any additional fees or charges are required authorization is hereby granted to charge any necessary fees to Deposit Account No. 19-2570 accordingly.

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned attorney at the number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Grace C. Hsu", is written over a horizontal line.

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